

II. General Remarks Concerning This Response

Claims 1-54 are currently pending. Claims 1, 10, 19, 28, 37, and 46 have been amended; no claims have been added or canceled. Reconsideration of the claims is requested.

5 A new set of formal drawings has been submitted with this response which corrects two minor problems with the figures. Reference numeral 123 has been added to Fig. 1B, which was missing in the original formal drawings but mentioned in the specification. In addition, the word "search" has been
10 changed to "searches" in box 722 of the flowchart in Fig. 7B so that the phrase is grammatically correct.

III. 35 U.S.C. § 102(e)-Anticipation-Van Stam

The Office action has rejected claims 1-3, 7-10, 13, 14,
15 17, 19-21, 25-28, 31, 32, 35, 37-39, 43-46, 49, 50, and 53 under 35 U.S.C. § 102(e) as being anticipated by Van Stam, "Intelligent Peer-to-Peer System and Method for Collaborative Suggestions and Propagation of Media", U.S. Patent Application Publication Number US 2003/0014759 A1, filed 12/21/2000
20 (effective filing date of at least 08/22/2000), published 01/16/2003. This rejection is traversed.

Van Stam discloses a computer system that facilitates peer-to-peer network interactions. In contrast to typical peer-to-peer interactions, though, Van Stam discloses a system
25 in which peer nodes in a peer-to-peer network correlate user preference information during a peer-to-peer search. This is briefly described in the "Summary of the Invention" section of Van Stam, which states in paragraph 0007:

5 A network-based intelligent system for predicting
ratings for items of media content according to how
likely they are to appeal to a user provides a parallel,
peer-to-peer system and method for collaborative
10 suggestions and propagation of media. ... An
originating client queries a targeted peer by
transmitting a list indicative of its user's preferences.
The targeted peer evaluates the similarity of the
transmitted list with a list of its own. If the two
15 clients are sufficiently similar, the comparison
continues in an interactive fashion. ... If the two
clients are dissimilar, either the originating client or
the targeted peer may terminate the query, depending on
the stage of the interaction; or the targeted peer may
20 route the query to a second targeted peer. The
interaction culminates in the originating client
downloading client listings from the targeted peer to
generate suggestions for the user. In addition to the
lists of preferences, the originating client may download
actual content items from the targeted peers.

As should be apparent by reference to the cited paragraph from
Van Stam, the peer nodes in a peer-to-peer network correlate
preferences that have been specified by users. If the
25 preferences lists of two users meet some statistical
threshold, then the peer-to-peer search may be regarded as
being successful and may be terminated at the successful node,
i.e., it would not forward the peer-to-peer search to another
peer node. In this manner, a search does not rely only upon
30 keyword matching; user preference information is used as a
type of metadata to narrow the scope of the search in an
effort to improve the quality of the results of peer-to-peer
searches, which are able to return an abundance of information
if there are many nodes within the peer-to-peer network.
35 Peer-to-peer searches typically result in many search
hits, and only a few files are typically retrieved after a

peer-to-peer search. Although the present invention and the system that is disclosed in Van Stam both provide an improved peer-to-peer search mechanism that should reduce the quantity of search hits and that should improve the quality of search hits, the methodologies are very different. The features of the present invention that are discussed hereinbelow are not disclosed in Van Stam but are reflected in the amended independent claims. Independent claim 1, as amended, contains the following elements (the amended language has been emphasized in a bold font):

obtaining a list of one or more keywords from a search query entered by a user of a first peer node;
sending a rating request message comprising the list of one more keywords to a server;
receiving a rating response message comprising a list of node identifiers from the server, wherein each listed node identifier identifies a node within a peer-to-peer network from which a file has previously been retrieved in response to a peer-to-peer search that used a keyword in the list of one or more keywords; and
initiating a peer-to-peer search from the first peer node by sending a search query message to a plurality of peer nodes, wherein the search query message comprises the search query, and wherein the plurality of peer nodes includes at least one peer node identified in the list of node identifiers from the server.

These claim elements are not disclosed in Van Stam nor the other prior art references of record.

With respect to the present invention, a peer-to-peer network improves its search results through a feedback mechanism that is based on the files that are retrieved in response to peer-to-peer searches. More specifically, a user or a peer node decides, in some manner, which file or files are retrieved after the peer-to-peer search results are

reviewed. The present invention does not capture the decision process. However, the present invention does capture the results of the decision process by making the following novel observation: it may be assumed that any file that is retrieved
5 from another peer node as a result of a search hit from a peer-to-peer search is much more significantly relevant with respect to other files that have not been retrieved in response to their associated search hits. Hence, the present invention implements a mechanism in which, for each completed
10 search, a peer node gathers rating information about file retrievals in response to search hits, and the peer node eventually forwards the rating information to a rating server; these features are reflected in dependent claim 3 and similar dependent claims. The rating results reflect the degree to
15 which peer-to-peer searches have successfully located content for keywords.

The interpretation of the present invention as supporting a feedback mechanism within a peer-to-peer network is completed by the following concept. Prior to initiating a new
20 peer-to-peer search, a peer node consults one or more rating databases at one or more servers to retrieve a set of initial nodes to which the peer node should initiate the new search, thereby maximizing the speed and success of finding relevant content. This particular feature is reflected in the amended
25 claim language, which has been added to all of the independent claims. The amended claim language specifically recites the content of a rating response message, i.e., "wherein each listed node identifier identifies a node within a peer-to-peer network from which a file has previously been retrieved in

response to a peer-to-peer search that used a keyword in the list of one or more keywords". After receiving this information, the peer node then performs the new search using the received list of node identifiers as identifying a set of
5 initial nodes for the peer-to-peer search.

In this manner, the present invention improves the results of a peer-to-peer search within the peer-to-peer network by limiting the number of root nodes that are used to initiate a search and by increasing the quality of the root
10 nodes that are chosen. This selection process is supported by databases that are maintained on central servers within the peer-to-peer network. These databases, termed "rating databases" in the claim terminology, contain information about files that have been retrieved in response to previous
15 searches on particular keywords. In essence, it is assumed that significantly relevant content has previously been found for particular keywords when a file is retrieved based on a search hit.

For these and other reasons, the subject matter in
20 amended independent claim 1 is not disclosed in Van Stam. The claims that depend from independent claim 1 incorporate the elements of claim 1; hence, the subject matter in these dependent claims is not disclosed in Van Stam. Independent claim 19 is directed to an apparatus that corresponds to the
25 method of independent claim 1, and independent claim 37 is directed to a computer program product that corresponds to the method of independent claim 1. Thus, independent claims 19 and 37 and their dependent claims are also not disclosed in Van Stam.

Whereas independent claim 1 is written from the perspective of a method that is performed at a peer node, independent claim 10 is written from the perspective of a method that is performed at a server that supports the rating
5 databases that are used by the peer nodes in a peer-to-peer network. Hence, the arguments that are provided above for distinguishing independent claim 1 over Van Stam are also applicable to independent claim 10, and the subject matter in amended independent claim 10 is not disclosed in Van Stam.
10 The claims that depend from independent claim 10 incorporate the elements of claim 10; hence, the subject matter in these dependent claims is not disclosed in Van Stam. Independent claim 28 is directed to an apparatus that corresponds to the method of independent claim 10, and independent claim 46 is
15 directed to a computer program product that corresponds to the method of independent claim 10. Thus, independent claims 28 and 46 and their dependent claims are also not disclosed in Van Stam.

As should be apparent by reference to Van Stam, the
20 explanation of the manner in which the present invention differs from Van Stam, and the explanation of the manner in which those differences are captured in the amended claims, Van Stam fails to disclose the present invention. Because the rejection has not shown the manner in which Van Stam discloses
25 the claimed features, as amended, the rejection has not pointed out the claimed features within the prior art as is required for a proper anticipation rejection. As stated at MPEP § 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly

or inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,
631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical
invention must be shown in as complete detail as is contained
5 in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, the
rejection is now improper in view of the amended claims, and
Applicant requests the withdrawal of the rejection.

10 IV. 35 U.S.C. § 103—Obviousness—Van Stam

The Office action has rejected claims 12, 15, 18, 30, 33,
36, 48, 51, and 54 under 35 U.S.C. § 103(a) as unpatentable
over Van Stam. This rejection is respectfully traversed.

The rejection of claims 12, 15, 18, 30, 33, 36, 48, 51,
15 and 54 relies on the examiner's invocation of Official Notice
for certain features, and the rejection then argues that the
features in these dependent claims are obvious in view of Van
Stam. However, as argued by Applicant above, Van Stam does
not disclose the elements of the amended independent claims
20 from which these dependent claims depend. Hence, Van Stam
does not disclose the claimed invention in the dependent claims
nor provide any suggestion to motivate one having ordinary
skill in the art to modify the prior art to reach the claimed
invention in the dependent claims. In general, the rejection
25 does not point out the necessary teachings, suggestions, or
incentives to reach the claimed invention. Hence, the
rejection of the claims does not establish a *prima facie* case
of obviousness based on the prior art. Therefore, the
rejection of the claims under 35 U.S.C. § 103(a) has been

shown to be insupportable, and these claims are patentable over the applied prior art. Applicant requests the withdrawal of the rejection.

5 V. 35 U.S.C. § 103—Obviousness—Van Stam in view of Carey et al.

The Office action has rejected claims 4-6, 11, 16, 22-24, 29, 34, 40-42, 47, and 52 under 35 U.S.C. § 103(a) as unpatentable over Van Stam in view of Carey et al., "System and Method for Performing Content Experience Management", U.S. Patent Application Publication Number US 2002/0112035 A1, filed 10/30/2000, published 08/15/2002. This rejection is respectfully traversed.

The rejection of the above-noted dependent claims relies on the anticipation rejection of the respective independent claims and the arguments in the rejection based on the disclosure of Van Stam. However, as argued by Applicant above, Van Stam does not disclose the elements of the claimed invention, as amended. Hence, by the inclusion of the subject matter of the independent claims into the above-noted dependent claims, Van Stam also does not disclose the subject matter of the dependent claims, and the rejection of the dependent claims is deficient.

More importantly, the rejection also relies upon Carey et al. as showing the feature of sending evaluation information and/or statistical information to a server. However, Carey et al. also fails to disclose the features as claimed by Applicant's patent application. As should be apparent from the discussion of the present invention above, the present

invention sends particular types of information from the peer nodes to a server as a consequence of particular types of operations, none of which is disclosed by Carey et al..

Hence, Carey et al. cannot be relied upon by the rejection to
5 remedy the deficiencies of Van Stam, and the disclosure of Carey et al. cannot be combined with Van Stam in any manner to reach the claim elements of Applicant's patent application, as amended.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when
10 rejecting claims under 35 U.S.C. § 103. In *re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness.
15 In *re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In *re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to the grant of a
20 patent. In *re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In *re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as
25 improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. In *re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

With respect to the claims, Van Stam in view of Carey et al. does not disclose the claimed invention nor provide any

suggestion to motivate one having ordinary skill in the art to modify the prior art to reach the claimed invention. In general, the rejection does not point out the necessary teachings, suggestions, or incentives to reach the claimed
5 invention. Hence, the rejection of the claims does not establish a *prima facie* case of obviousness based on the prior art. Therefore, the rejection of the claims under 35 U.S.C. § 103(a) has been shown to be insupportable, and these claims are patentable over the applied prior art. Applicant requests
10 the withdrawal of the rejection.

VI. Conclusion

It is respectfully urged that the present application is patentable, and Applicant kindly requests a Notice of
15 Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

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